

MAILED

OCT 15 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

The opinion in support of the remand being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES L. APPLE, JERRY L. DONZE, JAMES C. FAULK,
ROBERT BILLINGTON, GERALD M. GRAMMENS,
GERARD FITZPATRICK and TIMOTHY C. OSTWALD

Appeal No. 2003-0712
Application No. 09/451,574

ON BRIEF

Before FRANKFORT, MCQUADE and BAHR, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 for action consistent with the following remarks.

In a Memorandum to the Technology Center Directors and Patent Examining Corps dated April 29, 2002 on the subject of "[r]eliance upon abstracts and foreign language documents in support of a rejection," the Deputy Commissioner for Patent Examination Policy mandated that "[e]ffective immediately, no appeal should be forwarded to the Board of Patent Appeals and

Appeal No. 2003-0712
Application No. 09/451,574

Interferences for decision where . . . a rejection is supported in whole or part by a prior art document not in the English language, unless accompanied by a translation of the prior art document into English."¹

The instant appeal involves, inter alia, a 35 U.S.C. § 103(a) rejection of independent claim 22 as being unpatentable over Japanese Patent Document 6-40505. As the record does not contain a translation of this foreign language reference into English, it would appear that the examiner forwarded the appeal to this Board in contravention of the policy set forth in the Deputy Commissioner's memorandum.

On remand, the examiner is directed to correct this situation by:

a) obtaining a translation into English of Japanese Patent Document 6-40505;

b) reevaluating the subject rejection of claim 22 in light of the translation; and

c) issuing a supplemental examiner's answer, with a copy of the translation appended, stating whether the rejection is maintained or withdrawn, and explaining the rejection, if maintained, with reference to the translation.

¹ Most of the memorandum's content now appears in MPEP § 706.02.


Appeal No. 2003-0712
Application No. 09/451,574

If the rejection is maintained, the appellants, pursuant to 37 CFR § 1.193(b)(1), may file a reply brief to the supplemental answer within TWO MONTHS from the date thereof.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(D). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case.

REMANDED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. MCQUADE
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES


JENNIFER D. BAHR
Administrative Patent Judge

JPM/gjh

Appeal No. 2003-0712
Application No. 09/451,574

WAYNE P. BAILEY
STORAGE TECHNOLOGY CORPORATION
ONE STORAGE TEK DRIVE - MS 4309
LOUISVILLE, CO 80028-4309